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EXAMINER SUBRAMANIAN, NARAYANSWAMY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/775,599

Applicant(s)

GATTO, JOSEPH G.

Examiner

Narayanswamy Subramanian

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20, 24-37, 40-49 and 52-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-20, 24-37, 40-49 and 52-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This office action is in response to applicant's communication of July 24, 2008. Amendments to claims 24-31, 37, 40-44, and 52-54 have been entered. Rejections made under 35 USC § 101 and under 35 USC § 112, second paragraph in the last office action have been withdrawn in view of the amendments. Claims 3-20, 24-37, 40-49, and 52-54 are pending and have been examined. The rejections and response to arguments are stated below. Applicants are requested to note the Examiner's new art unit number (**AU 3695**) in their future correspondence.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-20, 24-37, 40-49, and 52-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 recites the limitation "top analysts that have a current estimate for the user-selected security". However the source of "top analysts that have a current estimate for the user-selected security" is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Also it is not clear what the applicants mean by the term "current estimate". Is it analyst's historical estimates or analysts' estimates for one or more future events or some other estimate? Hence the scope of the claim is not clear.

Claim 25 recites the limitation "analysts that have a predetermined track record of estimates for the user-selected security". However the source of "analysts that have a

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predetermined track record of estimates for the user-selected security” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 26 recites the limitation “other information relating to the user-selected security” (emphasis added). It is not clear what the applicants mean by this limitation particularly the emphasized phrase. The metes and bounds of this limitation are not clear.

Claim 27 recites the limitation “indication of whether an the analyst's estimate is above or below a consensus estimate”. However the source of “whether an the analyst's estimate is above or below a consensus estimate” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 28 recites the limitation “indication of whether an the analyst's estimate is above or below a consensus estimate and the difference between the analyst's estimate and the consensus estimate”. However the source of “whether an the analyst's estimate is above or below a consensus estimate and the difference between the analyst's estimate and the consensus estimate” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Also the limitation “the consensus estimate” lacks antecedent basis. Hence the scope of the claim is not clear.

Claim 29 recites the limitation “indication of whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount”. However the source of “whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount” is not clear. It is not clear if this

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information is retrieved from a database or if it is determined prior to the displaying step.

Hence the scope of the claim is not clear.

Claim 30 recites the limitation “indication of whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount”. However the source of “whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Also in the limitation “wherein the selected analysts are selected from a group of top analysts based on historical performance”, it is not clear what the applicants mean by the term “historical performance”. Is it “analyst's historical estimates” or “historical accuracy for an analyst” or some other measure? Similarly the source of “analysts whose historical accuracy satisfies a predetermined threshold” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 31 recites the limitation “indication of whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount and the difference between the analyst's estimate and the consensus estimate”. However the source of “whether the analyst's estimate exceeds a consensus estimate by a predetermined amount or is below a consensus estimate by a predetermined amount and the difference between the analyst's estimate and the consensus estimate” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Similarly the source of

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“analysts whose historical accuracy satisfies a predetermined threshold” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 37 recites the limitation “wherein the order in which the analysts appear is based on a rating of the analysts”. However the source of “the order in which the analysts appear is based on a rating of the analysts” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Also it is not clear as to how the ratings of the analysts are determined. Hence the scope of the claim is not clear.

Claim 40 recites the limitation “indication of whether a numerical value associated with the analyst's current recommendation is above or below a numerical value associated with a consensus recommendation for the at least one security”. However the source of “whether a numerical value associated with the analyst's current recommendation is above or below a numerical value associated with a consensus recommendation for the at least one security” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 41 recites the limitation “indication of whether a numerical value associated with the analyst's current recommendation is above or below a numerical value associated with a consensus recommendation for the at least one security, and the difference between the numerical value associated with the analyst's current recommendation and the numerical value associated with the consensus recommendation”. However the source of “whether a numerical value associated with the

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analyst's current recommendation is above or below a numerical value associated with a consensus recommendation for the at least one security, and the difference between the numerical value associated with the analyst's current recommendation and the numerical value associated with the consensus recommendation" is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 42 recites the limitation "indication of whether a numerical value associated with the analyst's current recommendation exceeds a numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the a consensus recommendation by a predetermined amount". However the source of "whether a numerical value associated with the analyst's current recommendation exceeds a numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the a consensus recommendation by a predetermined amount" is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 43 recites the limitation "indication of whether a numerical value associated with the analyst's current recommendation exceeds a numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the a consensus recommendation by a predetermined amount". However the source of "whether a numerical value associated with the analyst's current recommendation exceeds a

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numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the consensus recommendation by a predetermined amount” is not clear. Similar deficiency is present for the limitation “for the user-selected analysts whose historical performance satisfies a predetermined threshold”. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 44 recites the limitation “indication of whether a numerical value associated with the analyst's current recommendation exceeds a numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the a consensus recommendation by a predetermined amount, and the difference between the numerical value associated with the analyst's recommendation and the numerical value associated with the consensus”. However the source of “whether a numerical value associated with the analyst's current recommendation exceeds a numerical value associated with a consensus recommendation for the at least one security by a predetermined amount, or is below the numerical value associated with the a consensus recommendation by a predetermined amount, and the difference between the numerical value associated with the analyst's recommendation and the numerical value associated with the consensus” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Similarly the source of “analysts whose historical performance satisfies a predetermined threshold” is not clear. It is not clear if this

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information is retrieved from a database or if it is determined prior to the displaying step.

Hence the scope of the claim is not clear.

Claim 52 recites the limitation “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more exclusion factors, and wherein displaying further comprises displaying an indication of whether an the analyst's estimate is excluded from use in the aggregation prediction model”. However the source of “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more exclusion factors, and wherein displaying further comprises displaying an indication of whether an the analyst's estimate is excluded from use in the aggregation prediction model” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 53 recites the limitation “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more exclusion factors, and wherein displaying further comprises displaying an indication of whether the analyst's estimate is excluded from use in the aggregation prediction model and an indication of the reason for exclusion if the analyst's estimate is excluded from use in the aggregation prediction model”. However the source of “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more exclusion factors, and wherein displaying further comprises displaying an indication of whether the analyst's estimate is excluded from use in the aggregation prediction model and an

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indication of the reason for exclusion if the analyst's estimate is excluded from use in the aggregation prediction model” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Claim 54 recites the limitation “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more weighting factors, and wherein displaying further comprises displaying an indication of a weight applied to the analyst's estimate”. However the source of “model information relating to the use of the analyst's estimate in an aggregation prediction model; and wherein the model information comprises one or more weighting factors, and wherein displaying further comprises displaying an indication of a weight applied to the analyst's estimate” is not clear. It is not clear if this information is retrieved from a database or if it is determined prior to the displaying step. Hence the scope of the claim is not clear.

Dependent claims are rejected by way of dependency on a rejected claim.

Appropriate correction is required for all these claims.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 3-20, 24-37, 40-49, and 52-54 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a “**new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof**” (emphasis added).

The method claims 3-20, 24-37, 40-49, and 52-54 do not fall in the process category for the following reason. The claimed invention does not fall in the process category for the following reason. The Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process ‘either [1] was tied to a particular apparatus or [2] operated to change materials to a ‘different state or thing.’” In *Diehr*, the Supreme Court confirmed that a process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture.¹² 450 U.S. at 184. There, in the context of a process claim for curing rubber that recited an algorithm, the Court concluded that “transformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.”

In *Comiskey* (*In re Comiskey*) “the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.” *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. For the same reason, claims reciting incidental physical transformations also may not pass muster under section 101. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law.

In *Benson*, the Court reviewed the facts of several of its precedents dealing with process patents before drawing the conclusion that "transformation" is the clue to patent-eligibility "of a process claim that does not include particular machines." *Benson*, 409 U.S. at 68-71 (emphasis added). The cases *Corning* (tanning and dyeing), *Cochrane* (manufacturing flour), *Tilghman v. Proctor*, 102 U.S. 707 (1880) (manufacturing fat acids), and *Expanded Metal Co. v. Bradford*, 214 U.S. 366 (1909) (expanding metal), can all fairly be read to involve transformation of some article or material to a different state or thing. *Id.* at 69-70. *Benson* also compared *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854), to *The Telephone Cases*, 126 U.S. 1 (1888), reasoning that Morse's eighth claim was disallowed because it failed to recite any machinery for carrying out the printing of characters at a distance, instead simply claiming the use of "electromagnetism, however developed" for that purpose. *Id.* at 68. In contrast, Bell's claim in *The Telephone Cases* recited certain specified conditions for using a particular circuit for the transmission of sounds. *Benson*, 409 U.S. at 68-69.

These cases illustrate process claims where the recited machines played a central role in generating a useful result. In direct contrast, human-driven methods that merely recite a device that is insignificant to accomplishing the method (like the claim in *Grams*) and do not transform any article should not be recognized as a "process" claim similar to the above-cited cases. See *Diehr*, 450 U.S. at 191-92 ("insignificant post- solution activity will not transform an unpatentable principle into a patentable process). In the instant case, the preamble of the independent claims recite "A computer-implemented method for displaying information" which implies that displaying information is a critical or central step in the method. However the step of displaying simultaneously, on an

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analyst by analyst basis, relevant information does not appear to be performed by a particular apparatus. Nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. Hence the recited method of claims 3-20, 24-37, 40-49, and 52-54 do not qualify as a process under 35 USC 101. Dependent claims are rejected by way of dependency on a rejected claim. (See also *Ex Parte Langemyr*, Appeal 2008-1495, BPAI Decision May 28, 2008).

Response to Arguments

6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a) and § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3695

March 14, 2009